

REMARKS

Reconsideration and allowance of the claims are requested in view of the above amendments and the following remarks. The specification and claims 1-2, 5-6, 11 and 29-41 have been amended. New claims 42-43 have been added. Support for the amendments and the new claims may be found in the specification and claims as originally filed. For example, support for the claim amendments and new claims may be found in the specification at least at page 3, lines 2-27 and page 9, lines 8-10. No new matter has been added.

Upon entry of this amendment, claims 1-43 will be pending in the present application, with claims 1, 15, 26 and 29 being independent. Claims 15-28 have been withdrawn from further consideration as being drawn to a nonelected invention.

1. Restriction

The Office Action requires restriction to one of the following:

- I. Claims 1-14 and 29-41, drawn to extracting data, classified in class 707, subclass 102;
- II. Claims 15-25, drawn to evaluating multiple documents, classified in class 707, subclass 101; and
- III. Claims 26-28, drawn to accessing to and requesting data from web server, classified in class 707, subclass 10.

The Office Action states that during a telephone conversation with Mr. Stephen C. Siu, a provisional election was made without traverse to prosecute group I, claims 1-14 and 29-41. Applicant hereby affirms the election of group I, claims 1-14 and 29-41. New claims 42-43 are dependent on independent claims 1 and 29, respectively. Claims 15-28 have been withdrawn from further consideration as being drawn to a nonelected invention.

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2. Specification

The Office Action states on page 4 that the use of the trademarks GOOGLE, YAHOO, ASSOCIATED PRESS, REUTERS and NEW YORK TIMES should be capitalized and accompanied by generic terminology.

The specification has been amended to correct the usage of the trademarks as indicated in the Office Action.

3. Claim Objections

The Office Action on page 4 objects to claims 1-2 and 29-30 due to various informalities.

In regards to claims 1 and 29, the Office Action on page 4 asserts that the terms and phrase “extracting”, “grouping” and “the grouping step” are not consistent among elements and the claim preambles. Applicant respectfully disagrees.

Claim 1 is directed to a method for dynamically updating information for publication comprising a number of steps. Therefore, the terms “extracting”, “grouping” and “the grouping step” are consistent among the elements and the preamble of claim 1.

Additionally, claim 29 as amended is directed to a computer readable storage medium containing instructions for executing a method for dynamically updating information for publication, the method comprising a number of steps. Therefore, the terms “extracting”, “grouping” and “the grouping step” are consistent among the elements and the preamble of claim 29.

Claims 2 and 30 have been amended as indicated in the Office Action in order to overcome the objections to these claims.

For at least the reasons above, reconsideration and withdrawal of the objection to claims 1-2 and 29-30 are respectfully requested.

4. Rejections Under 35 U.S.C. §101

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The Office Action rejects claims 1-14 and 29-41 under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. Applicant respectfully traverses this rejection for at least the following reasons.

A. Claims 1-14

The Office Action on page 5 asserts that claims 1-14 are directed to an abstract methodology for which the steps do not produce a tangible result. Applicant disagrees.

35 U.S.C. §101 states (emphasis added):

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-14 are directed to a method (i.e., a process) and, therefore, fall within the categories of statutory subject matter specifically enumerated in 35 U.S.C. §101. Additionally, applicant notes that the Federal Circuit's decision in *State Street Bank*¹ stated (emphasis added):

The plain and unambiguous meaning of §101 is that any invention falling within one of the four stated categories of statutory subject matter may be patented, provided it meets the other requirements for patentability set forth in Title 35, i.e., those found in §§ 102, 103, and 112, ¶2. The repetitive use of the expansive term "any" in §101 shows Congress's intent not to place any restrictions on the subject matter for which a patent may be obtained beyond those specifically recited in §101 . . .

In other words, the *State Street Bank* decision held that the statutory subject matter requirement of 35 U.S.C. §101 should be broadly interpreted. For at least the reasons above, applicant submits that claims 1-14 of the present application recite statutory subject matter under 35 U.S.C. §101.

Furthermore, contrary to the assertions in the Office Action, applicant asserts that claims 1-14 are not directed to an abstract methodology, but instead produce a useful, concrete and

¹ *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*
149 F.3d 1368 (Fed. Cir. 1998).

tangible result. In *State Street Bank*², the Federal Circuit stated (emphasis added):

For purposes of our analysis, as noted above, claim 1 is directed to a machine programmed with Hub and Spoke software and admittedly produces a useful, concrete and tangible result . . . This renders it statutory subject matter even if the useful result is expressed in numbers such as a priced product, percentage, cost, or loss.

The *State Street Bank* decision held that a useful, concrete and tangible result could be expressed in non-physical terms. Independent claim 1 as amended recites a method for dynamically updating a collection of information in a database for publication. In one embodiment, at least a portion of the updated collection of information may be published on a web browser in response to a request from a user (see specification, page 12, lines 3-10). Therefore, claim 1 produces a useful, concrete and tangible result – an updated collection of information in a database for publication.

For at least the reasons above, claims 1-14 are directed to statutory subject matter and satisfy the requirements under 35 U.S.C. §101.

B. Claims 29-41

The Office Action on page 6 asserts that claims 29-41 are directed to a machine readable medium containing instructions which comprises wireless telecommunication signals and carrier waves, forms of energy. On the contrary, there is no indication anywhere in the specification or claims of the present application that the “computer readable medium” recited in the claims refers to a wireless telecommunication signal or carrier wave. In fact, the specification refers to, among other physical devices, a hard disk, magnetic disk, optical disk, magnetic cassettes, flash memory cards, etc. (see page 4, lines 19-25). There is no mention in the specification or claims of computer readable media taking the form of wireless telecommunication signals and carrier waves, or other forms of energy. Therefore, applicant disagrees with the rejection of claims 29-41 under 35 U.S.C. §101. However, for purposes of economy of prosecution, claims 29-41 have

² *Id.*

been amended to include a computer readable storage medium, as indicated in the Office Action. For at least the reasons above, claims 29-41 are directed to statutory subject matter and satisfy the requirements under 35 U.S.C. §101.

For at least the reasons above, reconsideration and withdrawal of the rejection of claims 1-14 and 29-41 under 35 U.S.C. §101 are respectfully requested.

5. Rejections Under 35 U.S.C. §112

A. 35 U.S.C. §112, First Paragraph

The Office Action rejects claims 1-14 and 29-41 under 35 U.S.C. §112, first paragraph. Specifically, the Office Action asserts that since the claims have been found to be directed to non-statutory subject matter or not supported by either an asserted utility or a well established utility, one skilled in the art clearly would not know how to use the claimed invention. Applicant respectfully traverses this rejection for at least the following reasons.

As discussed above, claims 1-14 and 29-41 are directed to statutory subject matter and satisfy the requirements under 35 U.S.C. §101. The rejection of these claims under 35 U.S.C. §112, first paragraph, are based only on the rejection of the claims under 35 U.S.C. §101 above. Therefore, since the rejection of the claims under 35 U.S.C. §101 have been overcome as discussed above, the rejection of claims 1-14 and 29-41 under 35 U.S.C. §112, first paragraph, are also overcome.

For at least the reasons above, reconsideration and withdrawal of the rejection of claims 1-14 and 29-41 under 35 U.S.C. §112, first paragraph, are respectfully requested.

B. 35 U.S.C. §112, Second Paragraph

The Office Action rejects claims 5-6, 11 and 33-34 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant respectfully traverses this rejection

for at least the following reasons.

In regards to claims 5 and 33, the Office Action asserts that the elements of “the top K features of rank” and “the top K features of a cluster” are indefinite because the range of “K” features is unclear. Additionally, the Office Action asserts that there is insufficient antecedent basis for the top K features. Claims 5 and 33 have been amended to overcome the rejection of these claims under 35 U.S.C. §112, second paragraph.

In regards to claims 6 and 34, the Office Action asserts that the element of “at least L common features” is indefinite because the range of “L” common features is unclear. Claims 6 and 34 have been amended to overcome the rejection of these claims under 35 U.S.C. §112, second paragraph.

In regards to claim 11, the Office Action asserts that the element “an item of received information may be grouped” is indefinite because it fails to particularly group the item. Claim 11 has been amended to recite “an item of received information is grouped” (emphasis added). Therefore, claim 11 is not indefinite.

For at least the reasons above, reconsideration and withdrawal of the rejection of claims 5-6, 11 and 33-34 under 35 U.S.C. §112, second paragraph, are respectfully requested.

6. Rejections Under 35 U.S.C. §103

The Office Action rejects claims 1-14 and 29-41 under 35 U.S.C. §103(a) as being unpatentable over Kubota (U.S. Patent 6,041,323) in view of Charnock et al. (U.S. Patent Application Publication No. 2003/0182310). Applicant respectfully traverses this rejection for at least the following reasons.

Kubota discloses a system for searching for stored documents that are similar to a document having one or more particular string characteristics (see col. 1, lines 8-14). A unique character string is extracted from an input document and a similarity search is performed by using the unique character string as the basis of the search (see abstract). However, Kubota fails

to disclose or suggest a method for dynamically updating a collection of information in a database including a plurality of pre-existing clusters of information, or the step of updating the collection of information by grouping received information with one or more pre-existing clusters in the collection that have characterizing features in common with the received information, as included in amended independent claim 1. Independent claim 29 has been amended to include similar elements.

Charnock et al. fails to cure this defect in Kubota. Charnock et al. discloses a system for organizing documents and in some cases, portions of their content, into causally related sets of information (see paragraph 0062). The system provides a search technique that returns sets of related documents that are not merely grouped by textual similarity, but also grouped and sequenced according to the social context in which they were created, modified or quoted (see paragraph 0063). This allows a precise set of documents to be retrieved from a large corpus of texts using simple search queries, with the added benefit of presenting the returned documents in the context of causally related documents even when those other documents do not, individually, satisfy the search criteria. Charnock et al. also discloses hierarchical clustering of documents (see paragraph 0304). However, Charnock et al. fails to disclose or suggest dynamically updating a collection of information in a database including a plurality of pre-existing clusters of information, or the step of updating the collection of information by grouping received information with one or more pre-existing clusters in the collection that have characterizing features in common with the received information, as included, in some form, in amended independent claims 1 and 29.

Therefore, since Kubota and Charnock et al., alone or in combination, fail to disclose or suggest all of the elements of independent claims 1 and 29, these claims are allowable.

Claims 2-14 depend from claim 1. Claims 30-41 depend from claim 29. As discussed above, claims 1 and 29 are allowable. For at least this reason, and the additional features recited therein, claims 2-14 and 30-41 are also allowable.

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For at least the reasons above, reconsideration and withdrawal of the rejection of claims 1-14 and 29-41 under 35 U.S.C. §103(a) are respectfully requested.

7. New Claims

New claims 42-43 are dependent on independent claims 1 and 29, respectively. As discussed above, claims 1 and 29 are allowable. For at least this reason, and the additional features recited therein, claims 42-43 are also allowable.

8. Conclusion

Accordingly, in view of the above amendment and remarks it is submitted that the claims are patentably distinct over the prior art and that all the rejections to the claims have been overcome. Reconsideration and reexamination of the present application is requested. Based on the foregoing, applicant respectfully requests that the pending claims be allowed, and that a timely Notice of Allowance be issued in this case. If the Examiner believes, after this amendment, that the application is not in condition for allowance, the Examiner is requested to call the applicant's attorney at the telephone number listed below.

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If this response is not considered timely filed and if a request for an extension of time is otherwise absent, applicants hereby request any necessary extension of time. If there is a fee occasioned by this response, including an extension fee that is not covered by an enclosed check please charge any deficiency to Deposit Account No. 50-0463.

Respectfully submitted,
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Date: November 20, 2006

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Kate Marochkina
Type or Print Name

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